

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) over the patent to Stratton '998.

Claims 1 and 3 are rejected under 35 U.S.C. 103(a) over the patent to Stratton '020 in view of DE 845.

Also, claim 1 is objected to.

In connection with the Examiner's objection to the claims, claim 1 has been amended correspondingly.

After carefully considering the Examiner's grounds for the objection of the claims over the art, applicant has amended claim 1, the broadest claim on file, so as to more clearly define the present invention and to distinguish it from the prior art.

It is respectfully submitted that the present invention deals with a method for producing wiper arms for a motor vehicles. A wiper arm is a component which connects a wiper blade with a swingingly movable shaft of the windshield wiper. In accordance with the present invention as defined in claim 1, at one side of one part a tongue 18 is punched which projects outwardly beyond the base contour of the one part, at a side which faces the at least one side of the one part the other part is punched so as to produce a recess 20 which corresponds to the tongue 18. As a result, a predetermined minimum distance is maintained between the parts 12a and 12b.

The novel features of the present invention which are now defined in the amended in the amended claim 1 are not disclosed in the references. The patent to Stratton '998 discloses a method of producing a main bracket of the supporting bracket frame of a wiper blade. It has nothing to do with a method of producing a wiper arm which connects the wiper blade with the swingingly movable windshield wiper.

The reference also does not disclose such a method of producing a wiper arm of a vehicle, in which the two parts punched out from at least one element are provided on the sides which face one another with

a tongue and with a recess which corresponds to the tongue, correspondingly. In the patent document DE 845 no tongues are shown which correspond to recesses of a neighboring punched part. These tongues are important, since from these tongues for example abutments for limiting a rotary angle can be formed. The recesses which correspond to these tongues are redundant. However, because of this redundancy, the punched parts can be produced with a substantially low material consumption, since the punching distances are reduced to a minimum.

These new features of the present invention which are now defined in the amended claim 1 are not disclosed in any of the references applied by the Examiner against the original claims.

Some claims were rejected over the patent to Stratton '988 as being anticipated. In connection with this, the Examiner's attention is respectfully directed to the decision In re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, this reference does not disclose all elements of the present invention as defined in claim 1, and therefore the anticipation rejection should be considered as no longer tenable and should be withdrawn.

The new features of the present invention which are defined in claim 1 can not be derived from the references as a matter of obviousness.

In order to arrive at the applicant's invention from the constructions disclosed in the references, the references have to be fundamentally modified. It is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not contain any suggestions for such modifications.

Finally, as explained herein above, the present invention as defined in claim 1 provides for the highly advantageous results in substantial material saving, which results can not be accomplished by the solutions proposed in the references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claim 1, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker
Attorney for Applicants
Reg. No. 27233